

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL GERLE,
HANS-ALBERT EHLERT
and EBERHARD KONIG

Appeal No. 2004-1832
Application 09/942,465

MAILED

AUG 6 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before PAK, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.
PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is not ripe for meaningful review and is, therefore, remanded to the examiner for appropriate action consistent with the views expressed below.

At page 4 of the Answer, the examiner sets forth, *inter alia*, the following rejection:

Claims 1-15 are rejected under 35 U.S.C. [§]103(a) as being unpatentable over Reiff et al. ('370 or '737) each in view of WO 99/52961.

The dispositive question raised by this rejection is whether it would have been obvious to employ the pyrazoles described in WO 99/52961 as the blocking agents for the isocyanates of the type described in Reiff et al. ('370 or '737).

As evidence of nonobviousness, the appellants rely on EP-A 942,023, EP-A 537,578 and U.S. Patent 4,834,767. See the Brief, pages 6 and 7. It appears to be the appellants' position that these prior art references demonstrate that one of ordinary skill in the art would not have been led to employ the pyrazoles described in WO 99/52961 as blocking agents in textile applications, such as those applications described in Reiff et al. See the Brief, page 7. However, on this record, the examiner has not explained why these prior art references, when viewed together with the prior art references relied upon by the examiner, would not have led one of ordinary skill in the art away from the claimed subject matter. See the Answer in its entirety. Specifically, the examiner has not indicated whether pyrazoles (blocking agents) or other prior art components promote permanent hydrophilicity, which according to the appellants, makes the resulting isocyanate product unsuitable for textile applications. Compare the Answer in its entirety with the Brief,

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page 7. As stated in *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a *prima facie* case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, **prior art references**, or argument, the entire merits of the matter are to be reweighed. (Emphasis added).

Upon return of this application, the examiner is to reweigh the entire merits of the Section 103 rejection of record taking into account the appellants' reliance on the above-mentioned references. Should the examiner remain of the opinion that the claims on appeal are unpatentable over the applied prior art references, the examiner is authorized to submit a Supplemental Answer pursuant to 37 CFR § 1.193(b)(1) (2003). The Supplement Answer should explain why the references relied upon by the appellants have not evinced that pyrazoles, such as those described in WO 99/52961, promote "permanent hydrophilicity property" which is unsuitable for textile applications.

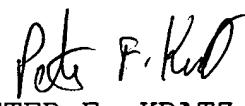
This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(d). It is important

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that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED


CHUNG K. PAK)
Administrative Patent Judge)


PETER F. KRATZ)
Administrative Patent Judge)


BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

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